

**Notice of Allowability**

Application No.

10/052,096

Examiner

Jessica R Baxter

Applicant(s)

CHAPPUIS ET AL.

Art Unit

3731

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment of 09 March 2004.
2. ☒ The allowed claim(s) is/are 2-9, 11-34 and 56-61.
3. ☒ The drawings filed on 29 April 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 9, 11 and 25 are generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 6-8, 12 and 26-34 are no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim. However, claims 35-44 remain withdrawn from consideration since the claims do not depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### **EXAMINER'S AMENDMENT**

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

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3. This application is in condition for allowance except for the presence of claims 35 to 44 non-elected without traverse. Accordingly, claims 35 to 44 have been cancelled.

*Allowable Subject Matter*

4. The following is an examiner's statement of reasons for allowance:

The prior art of record fails to disclose or suggest a surgical instrument comprising at least one cutting element transitionable between a retracted configuration and an expanded configuration and a tapping thread defined on said elongate member. This limitation, in combination with all of the limitations of claim 9, makes the claim allowable over the prior art.

The prior art of record fails to disclose or suggest a surgical instrument comprising a first cutting element comprising a tapping thread; and a second cutting element that is transitionable between a retracted and expanded configuration. This limitation, in combination with all of the limitations of claims 11 and 18, makes the claims allowable over the prior art.

The prior art of record fails to disclose or suggest a surgical instrument comprising a first cutting element adapted to be self-tapping and self-drilling; and a second cutting element that is transitionable between a retracted and expanded configuration. This limitation, in combination with all of the limitations of claim 14, makes the claim allowable over the prior art.

The prior art of record fails to disclose or suggest a surgical instrument comprising a tapping thread; and a cutting blade that is transitionable between a retracted and expanded configuration. This limitation, in combination with all of the limitations of claim 20, makes the claim allowable over the prior art.

The prior art of record fails to disclose or suggest a surgical instrument comprising a means for tapping threads; means for forming an enlarged cross-sectional portion; and means for transitioning the means for forming between a retracted and expanded configuration. This

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limitation, in combination with all of the limitations of claim 24, makes the claim allowable over the prior art.

The prior art of record fails to disclose or suggest a surgical instrument comprising a tapping portion and an expandable portion having at least one cutting element. This limitation, in combination with all the limitations of claim 25, makes the claim allowable over the prior art.

The prior art of record fails to disclose or suggest a surgical instrument comprising a tapping element and at least one cutting element transitionable between a retracted configuration and an expanded configuration. This limitation, in combination with all of the limitations of claim 56, makes the claim allowable over the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 703-305-4069. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

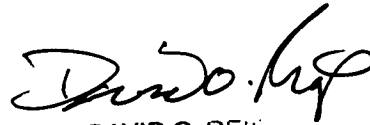
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on 703-308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica R Baxter  
Examiner  
Art Unit 3731

jrb



DAVID O. REIF  
PRIMARY EXAMINER